

### REMARKS

This Amendment is submitted in response to the Office Action dated May 28, 2003. The Examiner is requested to take note of the fact that applicant has elected new counsel to prosecute this case, and that all future correspondence should be forwarded to undersigned counsel in accordance with Form PTO/SB/81, submitted herewith.

Initially, the Examiner is thanked for the care and attention given this application. It is believed that the submissions set forth in this Amendment either meet or exceed the objections and rejections set forth in the Office Action, as set forth below. Reconsider and withdrawal is hereby sought.

Initially, the Oath/Declaration as objected to as failing to identify the mailing or post office address of the named, solo inventor. While undersigned counsel did not prepare the initial filings, it is noted that applicant, apparently, included both a declaration claiming small entity status (which is no longer required under the rules) as well as a traditional Declaration and Power of Attorney. The former did not, as observed by the Examiner, include an address, while the latter included the same. The source of confusion is obvious. However, in order to avoid any such concern, enclosed is an original, Executed Form PTO/SB/01, which properly lists the inventor's address and thereby obviates the issues. It is respectfully observed that, while the small entity declaration is no longer required, the proper declaration, as filed; did, in fact, include the applicant's then current address. Nonetheless, this formality and confusion resulting from the submission of an unnecessary small entity declaration (lacking in address) has been fully overcome and traversed by the enclosed Declaration. Withdrawal of this objection is thus respectfully solicited. Small entity status is still properly maintained.

The Examiner has also objected to claim 1 on the ground that semicolons were not utilized to separate claim elements. The amendment herein has corrected this objection, and thus withdrawal of this objection is respectfully sought.

Substantively, the Examiner has rejected the claims pursuant to 35 U.S.C. § 103(a) as alleged rendered obvious, and hence unpatentable, by the alleged combination of U.S. Patent No. 6,336,099 to Banrett, et al. (hereinafter the "'099 Reference") in view of U.S. Patent No. 5,249,044 to Von Kohorn (hereinafter the "'044 Reference".) Reconsideration and withdrawal of this rejection is respectfully solicited in light of the amendment to Claim 1, above (from which claims 2-12 depend) and the comments indicated below.

The instant invention is directed to a unique combination that provides a coupon for a product based upon real-time information, including, by way of example, the actual point-of-sale ("POS) data. In other words, how the product is actually selling at the moment of issuance of the coupon is taken into consideration as the coupon is generated. By way of example, if, for example, a supermarket has meat that is soon to expire, and its sales are down, it might wish to issue a discount coupon that will permit the recipient who, in this instance is watching television utilizing a system that connects (via PVR 14) the television (element 16) to the computer (20) to receive a discount coupon and then travel to the store and purchase, in this instance, the meat at a significantly reduced value. To those skilled in the art of short life coupons, this is a serious improvement over the art of record, since not only does it permit the timely sale of inventory (rather than necessitated disposal if expiration has already occurred), but it allows an interface via a computer (20) that is controlled by a PVR (14) controlled, in turn by a remote control (18) (that controls *both the PVR and the computer*) to interface with

*real time data* through the relay station 24 to the manufacturer's software short-life coupon generator (10) and obtain a coupon that enables a quick sale of excess inventory.

While this is but a short narrative of the invention, it is by no means an abbreviation or estoppel of all that is taught in the subject specification and claims as filed. Rather it is a direct exemplification of that fact that the references whether taken alone or in combination, do not address this claimed facet of the subject invention. Claim 1, as amended, now requires the receipt of "up to the minute point-of-sale information on the product of interest and coupon responses and redemption" which is taught at, *inter alia*, Page 5, lines 1 through 5 of the specification of the subject application.<sup>2</sup>

The Examiner has admitted that the '099 Reference does not teach an interface between an Internet-based computer system, and the age-old reference to the '044 Reference, which was also disclosed by the inventor in the subject specification. The '044 Reference shows some sort of transmission system that enables a user to employ a printer device to obtain a coupon while watching a television show. Likewise, the '099 Reference permits a user to obtain a coupon via the Internet. Applicant objects to the combination of references, especially since there is no hint or suggestion of taking these divergent areas of art and combining them, and without waiver of this argument has sought a more direct traversal that does not require either the applicant or the Examiner to contest this point. Likewise, the Examiner's view that certain elements of the dependent claims would have been obvious to her (without citation to the record or the references cited) could command a response request that she provide a qualifying affidavit of such personal knowledge under 37 C.F.R. §1.132. However, while applicant

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<sup>2</sup>Applicant reserves the right to "swear behind" the '099 reference (pursuant to 37 C.F.R. § 1.131) in the future. However, such action appears at present to be unnecessary since Claim 1, as amended readily distinguishes the claimed invention from that of the cited prior art.

reserves his right to raise these issues, it is not perceived as necessary at this juncture in light of the amendment to Claim 1 which obviates these issues as it *prima facie* overcomes the prior art of record, and would also permit the collaborative effort that applicant (via its representative) and Examiner are responsible to achieve. The Examiner is urged to call undersigned counsel to discuss the same, should issues still remain extant.

In short, none of the references, taken alone or in any combination, provide “up to the minute point-of-sale information on the product of interest and coupon responses and redemption” in combination with the other claimed elements, as taught in the specification at page 9 columns 1 through 5 and in amended claim 1. No new matter has been added, and the distinction from the prior art is readily apparent.

For example, there is no indication anywhere in ‘044 reference to actual real time POS data, the collection of the same, use or implementation. Over this there can be no reasonable argument. In terms of the ‘099 Reference to Barnett, et al., while there is a noted passing reference at column 5, lines 23-34 of information received from stores “as to which coupons were actually redeemed” there is no information concerning actual POS information regardless of coupon redemption *in real time* as an element of determining the issuance of a coupon. In fact, if redemption has occurred, then the coupon has already been issued and redeemed. In other words, such language teaches away from the real time POS sale component of the claimed invention, since if the coupon has already been redeemed, then it is after the POS information of how sales are proceeding has already been collected. Hence there can be no “real time” consideration of POS information via the ‘099 Reference.

To further buttress the absence of any such teaching, we respectfully direct the Examiner’s attention to element 30(e) of the ‘099 Reference entitled (in Figure 2) to “store-specific data.” Direction to column 10 lines 42, *et seq.* explains the meaning behind this entry

as the “data for different stores . . . and the user selects the store he intends on using at that particular time.” Thus, the thrust of the information gathered is not POS information concerning the product for which a coupon will thereafter issue, but it instead is intended to permit the user to select a local store, not that the store gathers actual, real time, information on a selected product and issues a coupon thereafter specific thereto dependent upon such real time information as required by the invention and reflected with clarity in amended Claim 1.

Indeed, the Examiner has interpreted the gathering of POS information as “the coupon distributor receives the specific coupon selection and information from the various retail stores as to which coupons are being redeemed.” (Office Action, paragraph bridging pages 3-4). Rather in the instant invention, the coupon distributor receives actual real time POS information *regardless of coupon redemption* and then issues coupons that reflect the actual sales and inventory, not after redemption but typically *prior* to both creation and redemption in order to determine the amounts and timing of the coupons to issue. This distinction is significant and, respectfully, traverses the grounds for rejection.

Since the remaining claims 2-12 are dependent from claim 1, and since, as submitted, claim 1 as amended defines a patentably distinct invention over the art of record, applicant reserves the right, if necessary, to discuss the points raised with respect to the dependent claims. Since the independent claim, however, is believed allowable, so too, the dependent claims, as they depend from allowable subject matter, need no further comment as such limitations are themselves allowable as a direct consequence of the dependency.

Applicant wishes to interview the Examiner after she has read the foregoing to discuss this amendment and determine whether any additional modifications need be made to pass this case to issue. It is thus respectfully requested, and the Examiner is urged to call undersigned counsel to arrange the same, unless the Examiner believes (which applicant believes to be appropriate) that the case is otherwise in present condition for allowance, which is respectfully sought.

Respectfully submitted,



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**FIG. 1**

# Spector Television

## Short Life Coupon System

